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EXAMINER

TOOMER, CEPHIA D

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/357,957

Filing Date: July 21, 1999

Appellant(s): LEVY, RICHARD

Robert J. Eichelburg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 24, 2007 appealing from the
Office action mailed April 11, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

08/943,125

10/614,114

09/359,809 (notice of defective brief)

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 29, 31, 32, 34-38, 41, 42, 48, 49, 53, 68, 72, 73, 85, 93 and 95-97.

Claims 30, 39, 40, 55, 57, 59, 61, 63-66, 75, 76 and 80-84 are allowed.

Claims 43, 56, 58, 60, 62, 67, 74, 77-79, 86-92 and 94 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Items 7-8 remain and are presented for review on appeal.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Items 1-6 and 9, which are the rejection of claims 29, 30, 31, 68, 72-79, 83 and their dependents under 35 U.S.C. 112, first paragraph, and the rejection of claims 29, 31, 35, 53, 55, 56, 61, 68, 72, 85, 93 and 95-97 under 35 U.S.C. 103(a) over Martineu, have been withdrawn in view of Applicant's arguments.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,792,717	TAKAYAMA	08-1998
5,275,760	JOHNSON	01-1994
4,340,706	OBAYASHI ET AL	07-1982

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29, 31, 32, 68, 72, 73, 85, 93 and 95-97 are rejected under 35 U.S.C. 102(b) as being anticipated by Takayama (US 5,792,717).

Takayama teaches a sliding material comprising a porous ceramic body that has open pores filled with a high water absorbing resin (see abstract). The ceramic body may be prepared from powdered boron nitride and the resin may be crosslinked-polyacrylates (see col. 3, lines 59-62; col. 4, lines 4-11; col. 5, lines 16-28). The resin absorbs at least 100 times its weight in water (see col. 4, lines 60-67). Takayama teaches that the composition has lubricity properties (see col. 4, lines 30-43).

Accordingly, Takayama teaching all the limitations of the claims anticipates the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 29, 31, 34-38, 41, 42, 48, 49 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,275,760) in view of Obayashi (US 4,340,706).

Johnson teaches a gelled corrosion inhibitor comprising a gelling agent slurried in a first medium and a corrosion inhibitor dissolved in a second liquid medium, wherein the gelling agent forms a gel in the second liquid medium (see abstract; column 3, lines 3-7). The gelling agents are water insoluble hydrogel-forming materials known in the art as super absorbent polymers (see col. 3, lines 21-23, 31-68). The gelling agent is carried as a slurry in an oil, such as fatty esters, mineral oils and lubricating oils (first medium). The corrosion inhibitor (lubricant additive) is dissolved in water (see col. 4, lines 39-55). The corrosion inhibitor may be an alkali or alkaline earth metal carbonate (applicant's carbonate) (see col. 4, lines 44-48). Johnson teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Johnson differs from the claims in that he does not specifically teach appellant's intended use. However, intended use is given little patentable weight in claims that are directed to the composition *per se*.

In the second aspect, Johnson differs from the claims in that he does not specifically teach that the super absorbent polymer absorbs greater than 100 times its weight in water. However, Obayashi teaches this difference. Obayashi teaches that the

cross-linked neutralized polyacrylic acid taught by Johnson absorbs at least 400-800 times its weight in water (see abstract; col. 6, lines 42-66).

It would have been obvious to one of ordinary skill in the art to have used the claimed polymers because Johnson teaches the use of super absorbent polymers and Obayashi teaches that these polymers absorb greater than 100 times their weight in water.

In the third aspect, Johnson differs from the claims in that he does not specifically teach that the oils are polymerized olefins. However, no unobviousness is seen in this difference because Johnson teaches that hydrocarbon oils may be used in the invention and this broad teaching encompasses polymerized olefins, which are hydrocarbon oils.

(10) Response to Argument

Appellant argues that Takayama teaches a monolithic boron nitride ceramic body article of manufacture that has open pores filled with a water absorbing resin. Appellant argues that this is not appellant's particulate boron nitride composition combined with a super absorbent resin, or the claimed "particulate" lubricant composition.

The boron nitride disclosed in Takayama is in particulate form before he forms it into the ceramic body. Takayama teaches that in order to arrive at his claimed invention that ceramic powder is used as the starting material. Preferred examples of the ceramic powder include boron nitride (see col. 3, lines 57-62; col. 4, lines 4-8). Thus, it is clear that Takayama teaches particulate boron nitride. It should be noted that appellant's claims do not exclude forming a ceramic body from the particulate boron nitride.

The examiner respectfully disagrees with appellant's argument that in order to apply Takayama to reject the present claims that the article must be used to lubricate a substrate. Appellant is claiming a lubricating composition of matter comprising a super absorbent polymer combined with a particulate lubricating metal nitride. The ceramic powders of Takayama are shaped into porous ceramic and the porous ceramic is filled with super absorbent polymers. Hence, Takayama teaches the limitations of a lubricating composition of matter comprising a super absorbent polymer combined with a particulate lubricating metal nitride, as set forth in the claims, and he does not require a substrate. Furthermore, since Takayama teaches that the ceramic material and polymer combination is used to form sliding material and Takayama teaches that the ceramic body exhibits an outstanding self-lubricating property (see col. 3, lines 13-22), these teachings set forth that the material has lubricating properties in the absence of a substrate. With respect to Takayama not teaching a "particulate" lubricant composition, the present claims do not set forth that the lubricant composition is a "particulate" lubricant composition.

Appellant argues that Takayama uses water to perform the lubricating operation. Appellant has set forth in claims 29 and 96 that the material for lubricating a surface optionally contains water. Therefore, Takayama is not teaching something that is outside of the scope of the present invention. Clearly, water may play a role in the lubricating composition of the present invention.

Appellant argues that Johnson does not teach the claimed lubricating composition because Johnson describes the use of oils with a polymer and the oils do

not bear chemical resemblance to the claim 29 inorganic materials for lubricating a surface or the silicate ester, polyphenyl ether, phosphate, biphenyl, phenanthrene or phthalocyanine compound.

Claim 29 sets forth that that material for lubricating a surface may be a carbonate in combination with a super absorbent polymer. Johnson teaches that a super absorbent polymer in a carrier oil is combined with an aqueous corrosion inhibitor. The corrosion inhibitor may be an alkali or alkaline earth metal carbonate, such as sodium carbonate. Appellant is broadly claiming a carbonate. Therefore, Johnson does teach the claimed inorganic lubricant. Appellant's lubricants are set forth in four groups, i.e., (1), (2), (3) or (4). Johnson teaches a carbonate and this compound would meet the limitations of group (1), wherein carbonate is present. Clearly, Johnson suggests the claimed lubricating composition.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided in Appellant's brief.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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